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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,236

09/08/2003

Hideaki Shiga

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23373

7590

06/23/2005

SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

TUPPER, ROBERT S

ART UNIT

PAPER NUMBER

2652

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/656,236

Applicant(s)

SHIGA, HIDEAKI

Examiner

Robert S. Tupper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 2, 4, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 4, the following have no antecedent basis: "metallic base portion" (lines 8 and 2 respectively) and "metallic upper lid" (lines 8 and 4-5 respectively).

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over NAKAMICHI (5,870,368).

Note figures 3-6. NAKAMICHI shows a disk drive with guides (1002 and 1003). NAKAMICHI teaches the use of low friction, anti-wear materials for the guides (see column 7 lines 65-67 and column 8 lines 28-31).

NAKAMICHI differs in that : (1) the system plays disks not mounted in cartridges, (2) the entire guide is made up of a low friction material rather than using a coating, and (3) not utilizing one of the listed low friction materials.

Concerning (1), it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of NAKAMICHI to systems utilizing disks mounted in cartridges, including known cartridges with rotary shutters (re claim 6). The motivation is as follows: one of ordinary skill in the art would certainly understand that the teaching of reducing friction and wear in the guiding the medium in a disk drive applies to both systems using disks cartridges as well as disks themselves.

Concerning (2), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a coating in place of making the guide entirely of the low friction material. The motivation is as follows: these are art recognized equivalents that operate in the same manner and produce the same results without any unexpected results.

Concerning (3), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize one of the listed low friction materials. The motivation is as follows: the listed materials are art recognized equivalents that operate in the same manner and produce the same results to the material utilized in NAKAMICHI.

5. Claims 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over SMITH (6,141,180).

Note figure 1. SMITH shows a magnetic tape cartridge drive with guide 100. SMITH teaches that the guide is made of a low friction, anti-wear material (see column 2 lines 33-40).

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SMITH differs in that: (1) the system utilizes a tape cartridge, (2) the entire guide is made up of a low friction material rather than using a coating, and (3) not utilizing one of the listed low friction materials..

Concerning (1), it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of NAKAMICHI to disk drive systems. The motivation is as follows: one of ordinary skill in the art would certainly understand that the teaching of reducing friction and wear in the guiding a cartridge applies to disk cartridge systems, including known disk cartridges with rotary shutters (re claim 6) as well as tape cartridge systems.

Concerning (2), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a coating in place of making the guide entirely of the low friction material. The motivation is as follows: these are art recognized equivalents that operate in the same manner and produce the same results without any unexpected results.

Concerning (3), it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize one of the listed low friction materials. The motivation is as follows: the listed materials are art recognized equivalents that operate in the same manner and produce the same results to the material utilized in SMITH.

6. Claims 1, 2, and 5 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

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7. It is noted that claim 4 is basically a duplicate of claim 2, so although claim 4 has only been rejected under 35 U.S.C. 112, 2nd paragraph, it has not been indicated as potentially allowable.

8. Applicant's arguments filed 5/13/05 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation to modify NAKAMICHI or SMITH to use a coating rather than an entire piece of low friction material. The Examiner does not agree. The motivation is that they are art recognized equivalents that act in the same manner and produce the same results.

Applicant also argues that the list of specific materials has been amended to Exclude the materials used in NAKAMICHI and SMITH, so that the claims reciting specific materials are now allowable. The Examiner does not agree. The listed materials are equivalents to those disclosed in NAKAMICHI and SMITH.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR.1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S. Tupper whose telephone number is 571-272-7581. The examiner can normally be reached on Mon - Fri, 6:30 AM - 4:00 PM (first Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 571-272-7579. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert S Tupper  
Primary Examiner  
Art Unit 2652

RST